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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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WILLIAM L. KLIMA 2046-C JEFFERSON DAVIS HIGHWAY STAFFORD, VA 22554			EXAMINER FISCHER, JUSTIN R	
			ART UNIT 1733	PAPER NUMBER

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/055,966

Applicant(s)

SMITH ET AL.

Examiner

Justin R. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 6-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 6-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 4, 6, 7, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As currently drafted, the claims include the following language: said photographic or digital image. However, the independent claims from which these claims depend from have been amended to eliminate the term "photographic"- the independent claims are solely related to colored digital images. It is suggested that the term "photographic" be deleted in the above noted claims to provide a clear and concise understanding of the claimed invention.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 4, 6-20, and 27-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazaki (US 6,235,376, of record).

Miyazaki is directed to a pneumatic tire construction in which the sidewall includes a colored picture or photograph (Column 11, Lines 40)- one of ordinary skill in the art would have recognized such language (picture or photograph) to include colored digital images. As to the portion of the sidewall surface that is covered with the above noted colored picture or photograph, one of ordinary skill in the art at the invention would have found it obvious to cover at least 50% of the sidewall depending on the desired aesthetic effect. It is emphasized that the degree to which the colored picture or photograph covers the tire outer surface represents an aesthetic characteristic that does not contribute to the mechanical function of the tire. For example, a user might desire a single picture or photograph to be displayed over the entire circumferential extent of the tire or a user might desire a number of different pictures/photographs. Absent any conclusive showing of unexpected results, one of ordinary skill in the art at the time of the invention would have found it obvious to form the colored picture of Miyazaki over at least 50% of the outer sidewall surface.

With respect to claims 4 and 6, as noted above, the degree to which the colored picture is arranged over the sidewall does not contribute to the mechanical function of the tire- it represents an aesthetic design choice that would have been well within the purview of one of ordinary skill in the art at the time of the invention depending on the desired aesthetic effect.

As to claims 7, 10-12, 14-17, and 19, the colored region of Miyazaki can be at least one of pictures, characters, symbols, photographs, and patterns- it is evident that the respective images can be formed of at least one color (e.g. photographs and

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pictures are generally multi-colored). One of ordinary skill in the art at the time of the invention would have recognized the arrangements of Miyazaki as including raised elements (e.g. patterns).

Regarding claims 8 and 9, a tire is recognized as having a texture and/or sculptured outer surface.

With respect to claims 13 and 18, the content of the picture or photograph does not contribute to the mechanical function of the tire- in this instance, the selection of a wide variety of images or designs, including a camouflage design, would have been well within the purview of one of ordinary skill in the art at the time of the invention.

Regarding claims 20 and 27-29, the color of the outer surface of the sidewall is independent of the characteristics of the colored digital image. Furthermore, the specific color of the outer surface of the sidewall and/or tread does not contribute to the mechanical function of the tire- it represents an aesthetic design choice that would have been well within the purview of one of ordinary skill in the art at the time of the invention depending on the desired aesthetic effect.

With respect to claim 30, it is well recognized that a tire is mounted on a rim to define a wheel assembly.

As to claims 31-34, the claims fail to further define the structure of the claimed tire article or wheel assembly- the claims are directed to the method of selecting and matching the color of the tire rubber to an additional tire component. It is additionally noted that such a selection is dependent on the desired aesthetic effect.

With respect to claims 35, 36, and 39-41, the formation of colored tires having a uniform color throughout its depth is extremely well known in the tire industry. One of ordinary skill in the art at the time of the invention would have found it obvious to form the tire of Miyazaki as a colored or non-colored (black) tire- the particular color of the tire does not contribute to the mechanical function of the tire but rather pertains to a desired aesthetic effect. It is further noted that the disclosed coloring agents represent the extremely well known and conventional agents used to form colored rubber compositions in the tire industry (particularly dyes and pigments).

Regarding claims 37 and 38, it is equally well known to form a tire in which the outer surfaces are not the same color. For example, the sidewall can be formed of a first color and the tread can be formed of a second color. It is emphasized that the particular selection of a tire having uniform or non-uniform outer surfaces is a design choice that would have been well within the purview of one of ordinary skill in the art at the time of the invention.

5. Claims 21, 23, 24, 26, and 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazaki as applied in claim 1 above and further in view of Ono (JP 08156501, of record) and Rogal (DE 19613801, of record).

While Miyazaki fails to expressly describe a tire construction in which the outer surface changes color with time, it is extremely well known in the tire industry to include such arrangements, primarily to indicate a tire characteristic (e.g. temperature, pressure) or provide a safety mechanism (e.g. improves visibility of tire), as shown for example by Ono and Rogal. It is further noted that the claims simply require that the

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outer surface of the sidewall is configured to change color with time- it appears that such a limitation is directed to an aesthetic effect that is separate and distinct from the inclusion of a colored digital image on the outer sidewall surface (colored outer surface is independent from the inclusion of colored digital image). One of ordinary skill in the art at the time of the invention would have found it obvious to form a portion of the outer sidewall surface with a color changing arrangement as such is commonly employed in modern day tire constructions. Lastly, the combination of aesthetic effects is not seen to further define the mechanical function of the tire.

Regarding claims 43-45, Ono recognizes arrangements in which the color changes with vehicle speed (increased temperature) and thus necessarily changes as a function of pressure (increase in vehicle speed accompanied by increase in pressure).

6. Claims 22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazaki as applied in claim 1 above and further in view of Porto (United States Statutory Invention Registration Number H1283, newly cited). As detailed above Miyazaki is directed to a tire construction that includes colored display information in the form of, among other things, pictures or photographs (generic to digital images). In this instance, the inclusion of said display information is independent of the characteristics of the tire outer sidewall and/or tread surface. It is extremely well known to form the tire outer surface with wear indicating means, in which case a particular color corresponds to a certain amount of wear (colors change over time and thus are irreversible). Porto provides one example of such a construction in which a wear indicating means is provided in the sidewall and the tread (Abstract). As noted above, the claim only

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requires that the outer sidewall surface is configured to change color with wear- this feature is separate and distinct from the inclusion of a colored digital image on the outer sidewall surface. The respective limitations each represent an aesthetic effect and their use individually or in combination would have been well within the purview of one of ordinary skill in the art at the time of the invention. One of ordinary skill in the art at the time of the invention would have found it obvious to form the tire of Miyazaki with a well known and conventional wear indicating means as such assemblies provide improved safety.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1, 3, 4, and 6-45 have been considered but are moot in view of the new ground(s) of rejection.

The rejections with Ono and Leguillon have been withdrawn in view of applicant's amendment. However, the rejection with Miyazaki has been maintained.

Applicant initially argues that the display label of Miyazaki only covers a small portion of the outer sidewall while the claim requires at least 50% of the outer sidewall surface. As detailed above, the degree to which the colored picture or photograph covers the tire outer surface represents an aesthetic characteristic that does not contribute to the mechanical function of the tire. Furthermore, the reference specifically teaches that the display information is formed by "at least one of" pictures, patterns, photographs, letters, symbols, etc.. This language suggests that one of ordinary skill in the art at the time of the invention would have readily appreciated a tire construction having a plurality of displays or arrangements and thus a tire in which a larger area of

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the outer sidewall surface contains a colored digital image. Absent any conclusive showing of unexpected results, one of ordinary skill in the art at the time of the invention would have found it obvious to form the colored picture of Miyazaki over at least 50% of the outer sidewall surface.

Applicant further argues that Miyazaki does not disclose digital images. Miyazaki teaches the inclusion of display information formed by at least one of pictures, patterns, photographs, etc.. In this instance, colored digital images are seen to represent a species of pictures and photographs. One of ordinary skill in the art at the time of the invention would have found it obvious to include digital images in the tire of Miyazaki as it represents one form of pictures and photographs. The particular type of display information does not appear to relate to the mechanical function of the tire but rather pertains to the desired aesthetic effect

Lastly, it is noted that several dependent claims define color characteristics of the outer sidewall and/or tread surface. These claims do not limit the characteristics of the colored digital image but rather further define the respective tire outer surfaces. In this instance, Miyazaki is not limited to placing display information on a non-colored (black) outer surface.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin R. Fischer whose telephone number is (571) 272-1215. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Justin R Fischer  
Primary Examiner  
Art Unit 1733

JRF